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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,174

10/07/2008

Jerome Cassayre

70310/US

1637

86344

7590

09/28/2011

Syngenta Crop Protection, Inc.,
Patent and Trademark Department
410 Swing Road
Greensboro, NC 27409

EXAMINER

BROWN, COURTNEY A

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

09/28/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,174	Applicant(s) CASSAYRE ET AL.	
	Examiner COURTNEY BROWN	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-11 is/are pending in the application.
- 5a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-8 and 11 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/18/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restriction

Applicant's election without traverse of Group I, claims 1-8 and 11 in the reply filed on August 15, 2011 is acknowledged.

Expanded Search

The elected species, Compound **III-49** when used in a method of combating and controlling insects, acarines, nematodes or molluscs was found to be free of the prior art. The search was expanded to include the full scope of instant Formula (I). Thus, the Examiner has expanded the forthcoming prosecution to include all claims relevant to the genus of Group I, for a first Office action and prosecution on the merits.

Status of Claims

Claims 1-11 are pending in the application. Claims 9 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims **1-8 and 11** will presently be examined to the extent they read on the elected subject matter of record.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e), 119(a-d), or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. This application is a 371 of PCT/IB04/04070 filed December 9, 2002 and claims priority to United Kingdom Application 0328907.1 filed December 12, 2003.

Information Disclosure Statement

The Information Disclosure Statements (IDS) submitted on July 18, 2006 has been considered by the examiner.

Claim Rejections - 35 USC § 112

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1-8 and 11** are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase optionally substituted, in claim 1, with respect to *R1, R2, R3, R4, R8 and Ra* is a relative phrase which renders the claims indefinite. The phrase *optionally substituted* is not defined by the claims, the specification does not provide an adequate standard for ascertaining the requisite degree, and one of ordinary skill in the art would

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not be reasonably apprised of the scope of the invention. The specification, on pages 4-8, provides a boiler plate list of optional substituents for *R1*, *R2*, *R3*, *R4*, *R8* and *Ra* and further discloses that the substituents themselves may be further *substituted*; however, the specification fails to explicitly limit the invention to any specifically disclosed embodiments. Consequently, the *substituted* spiro-condensed idolines of the formula (I) have been rendered indefinite by the use of the phrase *optionally substituted*.

The examiner suggests removal of the phrase *optionally substituted* and providing discrete substituents for each occurrence where substituents are desired, to overcome this rejection.

Claims 2-8 and 11 are rejected because they depend on rejected claim 1.

Conclusion

No claims are allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Fereydoun Sajjadi can be reached on 571-272-3311. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Courtney A. Brown
Patent Examiner
Technology Center 1600
Group Art Unit 1617

/JANET L. EPPS -SMITH/
Primary Examiner, Art Unit 1633